

U.S.S.N. 09/732,411

Filed: December 7, 2000

**AMENDMENT AND RESPONSE TO OFFICE ACTION****Remarks**

Claims 1, 3-5, 7, 11, and 16-19 are pending. Claims 2, 6, 8-10, 12-15, and 20-29 have been canceled. Claims 1, 3-5, 7, 11 and 16-19 have been amended. No new matter has been added.

**Rejection Under 35 U.S.C. § 112, first paragraph, enablement**

Claims 1, 3-5, 7, 8, 11-13 and 15-19 were rejected under 35 U.S.C. § 112, first paragraph, as not being enabled. Applicants respectfully traverse this rejection to the extent that it is applied to the claims as amended.

The claims have been amended to define peptides of a particular molecular weight and including specific peptides. Each is specifically demonstrated to inhibit binding, and appropriate cell types and ligands specifically identified. See page 19, line 21, to page 20, line 18. No new claims have been added. Each has been demonstrated to inhibit binding between a cell and either an integrin or a glycosaminoglycan. Secondary effects of the claimed peptides, if any (i.e. production of cytokines), have nothing to do with the claimed methods. It is well established there it is not enough for the examiner just to assert that the claims are not enabled. He must provide some evidence for why *one skilled in the art would not think it was not enabled*.

The Examiner is respectfully reminded that the Court of Appeals for the Federal Circuit (CAFC) has described the legal standard for enablement under § 112, first paragraph, as whether one skilled in the art could make and use the claimed invention from the disclosures in the patent coupled with information known in the art without undue experimentation (*See, e.g., Genentech,*

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*Inc. v. Novo Nordisk A/S*, 108 F.3d at 165, 42 USPQ2d at 1004 (quoting *In re Wright*, 999 F.2d 1557, 1561, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993); See also *In re Fisher*, 427 F.2d at 839, 166 USPQ at 24; *United States v. Telectronics, Inc.*, 857 F.2d 778 (Fed. Cir. 1988); *In re Stephens*, 529 F.2d 1343 (CCPA 1976)). The fact that experimentation may be complex does not necessarily make it undue, if the art typically engages in such experimentation (*M.I.T. v. A.B. Fortia*, 774 F.2d 1104 (Fed. Cir. 1985)). In addition, as affirmed by the Court in *Spectra-Physics, Inc. v. Coherent, Inc.*, 827 F.2d 1524 (Fed. Cir. 1987), a patent need not teach, and preferably omits, what is well known in the art.

**Rejection Under 35 U.S.C. § 112, first paragraph, written description**

Claims 1, 3-5, 7-8, 11-13 and 15-19 were rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventor had possession of the claimed invention. Applicants respectfully traverse this rejection to the extent that it is applied to the claims as amended.

The claims define specific peptides. The specification provides these sequences and demonstrate that each peptide has been shown to prevent binding of a cell to an integrin or glycosaminoglycan. There can be no issue about whether or not the applicants had possession of the claimed subject matter.

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### Rejection Under 35 U.S.C. § 102

Claims 1, 4, 5, 12, 13, 16 and 18-19 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,330,911 to Hubbell *et al.* ("Hubbell"). Applicants respectfully traverse this rejection to the extent that it is applied to the claims as amended.

A reference must teach each claimed element to anticipate.

Hubbell does not disclose any of the claimed peptides.

Therefore Hubbell does not anticipate the claimed subject matter.

### Election of Species

Applicants elected the species of SEQ ID NO:15. No art having been previously found which discloses the elected species, examination of the remaining species should now be conducted.

Allowance of claims 1, 3-5, 7, 11, and 16-19 is respectfully solicited.

Respectfully submitted,

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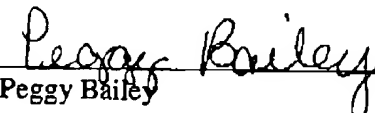
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**AMENDMENT AND RESPONSE TO OFFICE ACTION****Certificate of Facsimile Transmission**

I hereby certify that this Amendment and Response to Office Action, and any documents referred to as attached therein are being facsimile transmitted on this date, September 22, 2003, to the Commissioner for Patents, U.S. Patent and Trademark Office, Washington, DC 20231.

  
Peggy Bailey

Date: September 22, 2003

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